

## REMARKS

1. In response to the Office Action mailed October 4, 2005, Applicants respectfully request reconsideration. Claims 1-7, 11, 19, 21, and 22 were last presented for examination. In the outstanding office action all claims were rejected. By the foregoing Amendments, all claims have been amended. Claims 23-39 have been added. Thus, upon entry of this paper, claims 1-7, 11, 19, 21, 22 and 23-39 will be pending in this application. Of these 28 claims, three (3) claims (claims 1, 23 and 34) are independent. Based upon the above Amendments and following Remarks, Applicants respectfully request that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

### *Art of Record*

2. Applicants acknowledge receipt of form PTO-892 listing an additional reference cited by the Examiner.

### *Amendments to the Specification*

3. In response to an Office Action dated May 9, 2003, Applicants submitted a response on September 8, 2003 containing Amendments to the Specification. Applicants respectfully request that the Examiner acknowledge in next official communication that the Examiner has entered these Amendments.

### *Claim Amendments*

4. By the foregoing Amendments, Applicants have amended the claims to make the claims more readable. Applicants submit that the above Amendments do not narrow the scope of the claims. Applicants further submit that no new matter has been added.

5. New claims 23-39 have been added to further claim embodiments of the present invention.

### *Claim rejections*

6. Claims 1-7, 11 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,788,711 to Lehner, *et al.*, (hereinafter, "Lehner"), in view of U.S. Patent No. 6,517,476 to Bedoya, *et al.*, (hereinafter, "Bedoya").

7. In rejecting claim 1, the Examiner recognized that Lehner fails to teach “a releasable coupling unit disposed between said transducer and said micromanipulator . . . wherein said releasable coupling unit is a snap-in coupling,” as recited in Applicants’ claim 1. (See, Office Action, page 3.) The Examiner relies upon Bedoya for that which is missing from Lehner alleging that Bedoya teaches “a snap-in coupling.” (See, Office Action, page 3.)

8. Applicants respectfully request that the Examiner reconsider and withdraw the rejection for at least the reasons that the Examiner has failed to provide evidence of a proper motivation supporting the proposed combination of these references, and even if the references were combined as suggested by the Examiner, the proposed combination would still not contain all the elements of Applicants’ claim 1.

***The Combination of Lehner with Bedoya is prima facie Improper***

9. This rejection is *prima facie* improper because it provides no appropriate basis for combining Lehner with Bedoya. As set forth in the Manual of Patent Examining Procedure (MPEP) at § 706.02(j), “To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, *either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings* (emphasis added) . . . The teaching or suggestion to make the claimed combination and the reasonable expectation of success ***must both be found in the prior art and not based on applicant’s disclosure*** (emphasis added). *In re Vaeck*, 947 F.2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

10. In the rejection of claim 1, the Examiner asserts two possible reasons to explain why one of ordinary skill in the art would have been motivated to modify the teachings of Lehner to include the alleged snap-in coupling of Bedoya. Specifically, the Examiner asserts that “[i]t would have been obvious to modify the releasable coupling unit as disclosed by Lehner et al. to include a snap-in configuration as taught by Bedoya et al. in order to ***facilitate sealable interconnection . . . and selective interconnection . . .*** between the micromanipulator and the transducer. (See, Office Action, page 3, emphasis added.) In an attempt to demonstrate that this motivation has been gleamed from the references and not from the Applicants’ own disclosure, the Examiner has directed Applicants to small portions of the references. (See, Office Action, page 3.) Unfortunately, the portions cited by the Examiner fail to provide the teaching or suggestion that would motivate one of ordinary skill in the art

to make the combination proposed by the Examiner. In fact, the references in their entirety fail to support such a combination.

11. As held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references. (*See also In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”); *Also see, In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.”)).
12. Applicants respectfully submit that the Examiner has failed to meet the above burden in the rejection under 103. First, the Examiner’s assertion that it would have been obvious to one of ordinary skill in the art to modify Lehner to include a snap-in configuration as taught in Bedoya to facilitate sealable connection is entirely misplaced. Bedoya teaches a connector to provide electrical connection between implantable components of a system. (*See, Bedoya*, col. 5, lns. 25-49.) Due to the electrical connection capabilities of Bedoya, it is important to protect this connection by sealing out fluids and other harmful materials. In contrast, Lehner teaches a system wherein a “carriage has a receiver into which the desired implantable means [actuator/sensor] can be inserted without play. If mechanical decoupling or elastic bearing between positioning system and implantable means fixed in receiver is necessary, an elastic or spring-elastic intermediate piece can be inserted between the receiver and the implantable means.” (*See, Lehner*, col. 7, lns. 25-31.) As can be further seen in FIGS. 1 and 3 of Lehner, the entire actuator/sensor is placed into the receiver and does not necessitate an electrical connection with the micromanipulator. Therefore, because Lehner does not require an electrical connection between the micromanipulator and the transducer, there is no need to incorporate a “sealable connection” between the micromanipulator and transducer in Lehner, let alone a “snap-in coupling” to ensure operation as is required by Bedoya. Therefore, the need to provide a “sealable connection” between the micromanipulator and transducer would not have motivated one of ordinary skill in the art to make the combination suggested by the Examiner.
13. Furthermore, the Examiner’s assertion that it would have been obvious to one of ordinary skill in the art to modify Lehner to include an alleged snap-in configuration as taught in Bedoya to facilitate selective interconnection is equally misplaced. Bedoya

discloses a system that “provides for selective interconnection between two or more implantable components.” (See, Bedoya, Abstract.) Similarly, as noted above, Lehner teaches a system in which a “carriage has a receiver into which the desired implantable means [actuator/sensor] can be inserted without play. If mechanical decoupling or elastic bearing between positioning system and implantable means fixed in receiver is necessary, an elastic or spring-elastic intermediate piece can be inserted between the receiver and the implantable means.” (See, Lehner, col. 7, lns. 25-31.) Thus, because Lehner teaches that mechanical decoupling, ie. detachment or interconnection, is possible simply by inserting an elastic or spring-elastic intermediate piece between the receiver and the actuator/sensor, “selective interconnection” can easily be achieved in Lehner alone. Therefore, because Lehner already discloses a means for “selective interconnection,” there is no reason to incorporate the alleged snap-in connector of Bedoya to accomplish this purpose. Therefore, Applicants submit that the need to provide a “selective interconnection” between the micromanipulator and transducer would not have motivated one of ordinary skill in the art to make the combination suggested by the Examiner.

14. For the above reasons, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* rejection under 35 U.S.C. §103, and for at least this reason the rejection should be withdrawn.

***The Proposed Combination Still Does not Contain All Elements of Applicants’ Claim 1***

15. Even if the references were modified in the manner proposed by the Examiner, the resulting combination would still fail to contain all elements of the claimed invention. As set forth in the MPEP at §2142 “to establish a *prima facie* case of obviousness... the prior art reference (or references when combined) must teach or suggest all of the claim limitations.”

16. As noted by the Examiner, “Lehner et al. fails to disclose the releasable coupling being a snap-in coupling.” (See, Office Action, page 3.) However, Examiner is mistaken in asserting that Bedoya teaches this element. (See, Office Action, page 3.) Bedoya completely fails to teach or suggest “a releasable coupling unit disposed between said transducer and said micromanipulator, said coupling unit, in an assembled state, fixing said transducer with respect to said micromanipulator, and, in a released state, permitting removal of the transducer from the micromanipulator, and wherein said releasable coupling unit is a snap-in coupling that enables replacement of said transducer while maintaining said position set by said micromanipulator prior to removal without readjustment of said

micromanipulator” as recited in Applicants’ claim 1. As noted above, Bedoya teaches a connector to provide electrical connection between implantable components of a system “that is configured for snap-in sealable engagement with an internal surface defined within an external housing.” (See, Bedoya, col. 5, lns. 25-49; col. 8, 56-65.) This snap-in connector disclosed in Bedoya differs from “a releasable coupling unit disposed between said transducer and said micromanipulator . . . wherein said releasable coupling unit is a snap-in coupling” as recited in Applicants’ claim 1 because the Bedoya connector merely provides electrical connection between components rather than “fixing said transducer with respect to said micromanipulator, and, in a released state, permitting removal of the transducer from the micromanipulator” as recited in Applicants’ claim 1.

17. Therefore, for at least the reason that neither Lehner or Bedoya teach the coupling claimed in Applicants’ claim, Applicants’ assert that the rejection under §103 was improper and should be withdrawn.
18. For the reasons discussed above, Applicants’ submit that independent claim 23 is non-obvious over the art of record and that the art of record fails to teach or suggest all elements of independent claim 23.
19. For the reasons discussed above, Applicants’ submit that independent claim 34 is non-obvious over the art of record and that the art of record fails to teach or suggest all elements of independent claim 34.

***Dependent claims***

20. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicants respectfully assert that the dependent claims are also allowable over the art of record.

***Conclusion***

21. In view of the foregoing, this application should be in condition for allowance. A notice to his effect is respectfully requested.
22. Applicants reserve the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application, cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicants reserve the right to pursue such claims in a continuation or divisional application.

Respectfully submitted,

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